

Remarks

Applicant thanks the Office for its courtesy in participating in a telephonic interview with the undersigned on May 6, 2003, to discuss the above-identified application. In response to the above-identified final Office Action, Applicant has amended claims 1, 11 and 21 as explained further herein below. Support for the amendments to claims 1, 11 and 21 can be found at page 5, lines 8-17, and page 9, lines 5-8, in the above-identified patent application. Accordingly, no new matter has been entered by way of these amendments. In view of these above amendments and the following remarks, Applicant hereby requests further examination and reconsideration of the application, and allowance of claims 1-30.

An initialed copy of Form PTO 1449 submitted for the Office's consideration on December 8, 2000 was not received by the Applicant. Accordingly, Applicant respectfully requests that a copy of the initialed Form PTO 1449 be included in a subsequent action.

The Office has rejected claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,732 to Tarbox ("Tarbox") in view of U.S. Patent No. 5,794,207 to Walker et al. ("Walker"). In particular, the Office asserts that Tarbox discloses all the method/system claims related to electronically selling information (i.e., investment advice) to a buyer (i.e., investor), wherein the method/system comprises: receiving an offer (i.e., fee(s)) for the information including at least one contingency from the buyer; providing the information in response to the offer; and receiving a first payment for the information if at least one condition for the contingency is satisfied after the information has been provided to the buyer (see col. 3, lines 21+; col. 2, lines 4-46). The Office concedes that Tarbox fails to disclose sending a counteroffer to the buyer based on the offer, but asserts that sending counteroffers to buyers based on offers is disclosed by Walker (see at least col. 9 and col. 11, lines 5-51). The Office further asserts that it would have been obvious to integrate the counteroffer feature allegedly disclosed by Walker into the Tarbox system because the ability to counteroffer would allow making recommendations that cater to participants' financial needs. In response, Applicants have amended claims 1, 11 and 21 as shown herein and submit the following remarks.

Neither Tarbox nor Walker, alone or in combination, disclose or suggest, “providing the information in response to the offer, the information includes at least one condition about the at least one contingency, wherein the at least one condition is unsatisfied when the information is provided,” as recited in claims 1, 11 and 21. The Office’s attention is respectfully directed to Tarbox at col. 3, lines 21-27 and FIG. 1, which discloses a system 10 that provides professional asset allocation advice services 12 to participants 14 in Benefit Plans for allocating their account balances in trusts 20, 22, 24, 26. The trusts 20, 22, 24, 26 are specifically tailored to the participant’s 14 individual risk tolerances and retirement funding needs, as disclosed at col. 3, lines 26-27. Applicant now directs the Office’s attention to col. 3, lines 47-53; col. 6, lines 20-46; and FIG. 2 in Tarbox, which disclose a participant advisor 32 providing plan participants 14 with asset allocation and investment recommendations 44 with respect to which trusts 20-26 they should invest in. But, the asset allocation and investment recommendations 44 are not provided by the participant advisor 32 with any conditions with respect to their recommendations 44, let alone any conditions that are unsatisfied when the recommendations 44 are provided to the participants 14 as claimed.

The Office’s attention is now directed to Walker at col. 16, lines 12-28, which discloses a buyer generating a conditional purchase offer (“CPO”) 100 for some good sought to be purchased by the buyer. The CPO 100 includes conditions or descriptions of the goods sought by the buyer, as disclosed at col. 16, lines 22-23. For instance, a buyer may specify that they only want a nonstop ticket on a flight arriving at a destination city before midnight, as disclosed at col. 16, lines 20-22. Referring to Walker at col. 19, lines 13-16 and FIGS. 10-11, a seller selects a CPO 100 to bind. By binding the CPO 100, the seller asserts that the goods delivered to the buyer satisfies the conditions specified in the CPO 100. Thus, the goods (i.e., airline tickets) provided to the buyer do not have at least one unsatisfied condition as claimed. Referring to page 5, lines 8-25, in the above-identified application, information goods are any kind of knowledge in tangible and intangible form. A contingency is an uncertainty about something occurring, disclosed at page 5, line 11. As an example, a contingency in an information good may comprise: “What will the price of Company X’s stock be on December 31, 2003?”, as disclosed at page 5, lines 17-19. A condition is a premise upon which fulfillment of the contingency depends, as disclosed at page 5, line 17. An example of a condition set by a seller and included with the information good in response to a buyer’s offer for the good is: “Company X’s stock will be \$ 10 on December 31, 2003,” as disclosed at page 5, line 20. Accordingly, the conditions which are associated with the information goods provided to the buyers are unsatisfied when the information good is provided to the buyer.

Referring now to page 2, lines 7-25 in the above-identified application, the lack of a trustworthy system for selling contingent information goods which ensures that sellers set honest and realistic conditions for the contingencies associated with the goods has created economic inefficiency. Heretofore, sellers would make unreasonable assertions to buyers in establishing their conditions for the contingencies to all but guarantee the conditions are met, as disclosed at page 2, lines 11-12. For example, a seller may set a condition for the contingency of the Company X's stock price at a future date as being that the stock's price will be greater than zero on December 31, 2003, as disclosed at page 2, lines 13-14. By ensuring that sellers are paid only as a function of the condition's outcome upon which the contingencies are based, the embodiments of the present invention increase the likelihood that more contingent information goods will be transacted between sellers and buyers since buyers can feel confident the sellers are setting honest and reliable conditions, as disclosed at page 3, line 27 through page 4, line 2, in the above-identified application. In view of the foregoing amendments and remarks, the Office is respectfully requested to reconsider and withdraw the rejections of claims 1, 11 and 21. Since claims 2-10 depend from and contain the limitations of claim 1, claims 12-20 depend from and contain the limitations of claim 11, and claims 22-30 depend from and contain the limitations of claim 21, they are patentable in the same manner as claims 1, 11 and 21.

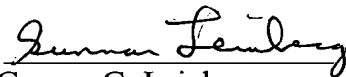
Additionally, neither Tarbox nor Walker, alone or in combination, disclose or suggest, "adjusting an amount for the first payment based on a probability that the condition for the contingency will occur," as recited in claims 3 and 23, or "the contingent payment processing system adjusts an amount for the first payment based on a probability that the condition for the contingency occurs," as recited in claim 13. As stated above in connection with Tarbox, the disclosure is silent with regard to the participant advisor 32 providing any conditions with their recommendations 44. Furthermore, and referring now to col. 7, line 66 through col. 8, line 16 in Tarbox, the participant advisor 32 receives a reasonable compensation that is not tied to the level of the assets under management in the trusts 20, 22, 24, 26 or anything else, such as conditions (which are not even present), let alone the compensation being adjusted based on probabilities that the conditions will be satisfied. Referring to Walker at col. 16, lines 49-51, a buyer enters a price for goods desired during construction of the CPO 100. But, once the seller binds the CPO 100 and the goods are delivered, the seller receives payment for the goods pursuant to the terms set forth in the bound CPO 100. Again, Walker does not teach nor suggest goods being provided to the buyers with unsatisfied conditions when they are delivered, let alone making adjustments to the price originally entered for the goods by the buyer in constructing the CPO 100 based on any probabilities of whether these (absent) conditions will be satisfied.

The embodiments of the present invention make it even more likely that the seller will accurately predict a probability of a condition for the contingency occurring by tying the amount of the payment the seller receives for the contingent information good to the accuracy of the prediction and the probability against the true probability of the actual result, as disclosed at page 4, lines 3-11 in the above-identified application. As mentioned above, ensuring that sellers are paid only as a function of the outcome of the condition on which the contingencies are made increases the likelihood that more contingent information goods will be transacted between sellers and buyers. In view of the foregoing remarks, Applicant respectfully submits that claims 3, 13 and 23 are distinguishable over the cited references and are patentable for these additional reasons.

In view of all of the foregoing, it is submitted that this case is in condition for allowance and such allowance is earnestly solicited. In the event that there are any outstanding matters remaining in the above-identified application, the Office is invited to contact the undersigned to discuss this application.

Respectfully submitted,

Date: January 22, 2004


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